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EXAMINER

STRANGE, AARON N

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DEAN MOSES, ED ANUFF, FERGUS GRIFFIN, JEAN  
TESSIER, HANS AKENSSON, JOHN PETERSEN, THOM BELUNIS,  
EDITH HARBAUGH, NOAH GUYOT, DAVE MACLEOD,  
AMY PHILLIPS, and ETHAN VONDCRWEID

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Appeal 2008-000176  
Application 10/091,513  
Technology Center 2400

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Decided: June 11, 2010

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Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-44. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). We Affirm.

### Invention

Appellants' invention relates to a method, a system and a computer program product for providing a site as a collection of software web objects. More particularly, the invention on appeal relates to a method, a system and a computer program product for providing a site as a collection of web objects that can be manipulated by a set of users having assigned privileges defined by permissions associated with each software web object in the collection of objects. (Spec. 1).

Claim 1 is illustrative:

1. A method of sharing an object in a portal framework, the method comprising the steps of:
  - storing a reference to the object in a first repository, wherein the object is an invokable software object; and
  - performing a first operation to store a duplicate of the reference to the object in a second repository;
  - wherein the first operation is in accordance with a first privilege granted as defined by a permission.

Appellants appeal the following rejection:

1. Claims 1-44<sup>1</sup> as unpatentable under 35 U.S.C. § 103(a) over the combination of Stefik (U.S. Patent 6,236,971 B1, May 22, 2001), and Chang (U.S. Patent Application Publication No. 2002/0078377 A1, Jun. 20, 2002).

### ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Under § 103, did the Examiner err by finding that the combination of Stefik and Chang would have taught or suggested storing a duplicate of a reference to an object, within the meaning of representative claim 1?
2. Did the Examiner err by improperly combining the Stefik and Chang references under § 103?

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<sup>1</sup> We note that dependent claim 42 improperly depends from itself. *See* 35 U.S.C. § 112, 4<sup>th</sup> paragraph. We assume this oversight to be a typographical claim drafting error that will be corrected by amendment in the event of further prosecution.

### FINDINGS OF FACT

1. Stefik teaches a system for controlling the distribution and use of digital works using digital tickets where a ticket is described as “an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service.” (Col. 4, ll. 7-11).
2. Stefik teaches storing a digital ticket in a repository (col. 51, ll. 42-43).
3. Stefik teaches another repository obtaining a copy of the digital ticket whereby the digital ticket is possessed by the repository. (col. 51, ll. 45-46, 54-57).
4. Stefik teaches that digital works may be content, e.g., a photograph, or digital works can also be executable software programs. (Col. 8, l. 66 through col. 9, l. 1).
5. Chang teaches invoking operations on remote objects in a distributed environment. (paras. [0037-0038]).

### GROUPING OF CLAIMS

Appellants argue all of the rejected claims as a single group, specifically addressing independent claim 1. (*See* App. Br. 12). We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(vii).

## ANALYSIS

### Issue 1

We decide the question of whether the Examiner erred by finding that the combination of Stefik and Chang would have taught or suggested storing a duplicate of a reference to an object, within the meaning of representative claim 1.

Appellants contend that the term “‘reference to an object’ as used in the art is understood to mean a reference that points to the location of an object in a database or file system and identifies the object type (for example, a pointer).” (App. Br. 12, ¶2).

The Examiner reads the claimed “reference to an object” on Stefik’s teaching of a digital ticket. (Ans. 8; *see also* FF 1). Specifically the Examiner finds that Stefik’s “ticket is a reference to an object because it refers to or associates with an object (i.e., a digital work).” (Ans. 8, ll. 2-4).

We begin our analysis by broadly but reasonably construing the claimed “reference to an object.” (Claim 1). During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

We observe at the outset that Appellants’ argued definition for the term “reference to an object” (i.e., as a pointer to a location of an object in a database of a file system that also identifies the object type) is not accompanied by a citation to specific support in Appellants’ Specification. (App. Br. 12, ¶2). However, after reviewing the specific portions of Appellants’ Specification listed under the “Summary of the Claimed Subject

Matter” section of the principal Brief (p. 4), we find nothing more than the claimed phrase itself as support: *See e.g.*, “reference to the object” (Spec. 43, l. 14) or “reference to an object.” (Spec. 43, l. 10).

On this record, we conclude that the Examiner’s interpretation, while broad, is reasonable in light of Appellants’ Specification. Although Appellants strenuously argue that the term “reference to an object” is *a pointer to a location of an object in a database of a file system that also identifies the object type* (App. Br. 12, ¶2), we observe that these argued additional limitations are not recited in representative claim 1. We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). A basic canon of claim construction is that one may not read a limitation into a claim from the written description. *Renishaw plc v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998).

This reasoning is applicable here. We will not endeavor to read Appellants’ argued limitations into the claim. Appellants could have amended their claims during prosecution to recite the specific argued limitations to clarify the meaning and intended scope of the disputed claim term “reference to an object.” However, Appellants chose not to do so. Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

For the aforementioned reasons, we agree with and adopt the Examiner's claim construction of the claim term "reference to an object" as an entity that "refers to or associates with an object." (Ans. 8, ll. 2-4, underline added).

Given this construction, we agree with the Examiner's finding that the combination of Stefik and Chang would have taught or suggested storing a duplicate of a reference to an object, within the meaning of representative claim 1. We note that Stefik teaches storing a digital ticket (reference to an object) in a repository. (FF 2). Stefik teaches another repository obtaining a copy of the digital ticket whereby the digital ticket is possessed by the repository. (FF 3). We conclude that Stefik's teaching of the copy (duplicate) digital ticket being "possessed by the repository" is sufficiently suggestive of the copied (duplicate) ticket (reference to the object) being stored in a different (second) repository so as to render Appellants' representative claim 1 obvious to an artisan at the time of the invention.

Therefore, for essentially the same reasons argued by the Examiner, and as discussed above, we find the Examiner did not err in finding that the combination of Stefik and Chang would have taught or suggested storing a duplicate of a reference to an object, within the meaning of representative claim 1.

### Issue 2

We decide the question of whether the Examiner erred by improperly combining the Stefik and Chang references under § 103.



Appellants strenuously argue that the Examiner has failed to show a suggestion or motivation to combine the teachings of Stefik and Chang. (App. Br. 16-17). Appellants further contend that the Examiner's proffered combination would result in unacceptable performance and also that the Examiner has not demonstrated a reasonable expectation of success. (App. Br. 17-18).

At the outset, we observe that the Examiner merely looks to the secondary Chang reference as evidence that invokable software objects were known to artisans at the time of Appellants' invention. (Ans. 3-4; *see also* FF 5). Given this context, we find the thrust of Appellants' arguments attacking the proffered combination of Stefik and Chang are grounded on an erroneous premise, i.e., the incorrect premise that the Examiner's rejection is based upon a physical or bodily incorporation of Chang into the invention of Stefik.

"What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (citations omitted); *see also In re Nievelt*, 482 F.2d 965, 968 (CCPA 1972) ("Combining the *teachings* of references does not involve an ability to combine their specific structures."). The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of those references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

This reasoning is applicable here. Thus, we are in agreement with the Examiner that an artisan would have found it obvious to apply the usage and distribution rights associated with Stefik's digital ticket to Chang's executable (invokable) software objects. (Ans. 3-4; *see also* FF 5). We find the Examiner's proffered combination is further buttressed by Stefik's teaching that digital works can also be executable (i.e., invokable) software programs, as opposed to being limited to non-executable content, such as a digital photograph. (FF 4). Moreover, because an executable software program ("digital work" as taught by Stefik) may be reasonably considered as an "invokable software object," we find the portion of Chang relied on by the Examiner is essentially cumulative to the teachings of Stefik.<sup>2</sup>

Based on this record, we are of the view that Appellants' purported improvement over the prior art represents no more than the predictable use of prior art elements (i.e., software objects, references to the objects, and data repositories) according to their established functions, and thus would have been obvious to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.* 550 U.S. 398, 417(2007) ("when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious.") (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

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<sup>2</sup> We note that Stefik also contemplates object oriented concepts. (Col. 10, ll. 42-44).

Moreover, given the breadth of Appellants' representative claim 1, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner would have been "uniquely challenging or difficult for one of ordinary skill in the art" at the time of Appellants' invention (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner's proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.<sup>3</sup>

Lastly, we note that Appellants have not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

Thus, when we take account of the inferences and creative steps that a person of ordinary skill in the art would have employed, we find the Examiner has articulated an adequate reasoning with a rational underpinning that reasonably supports the legal conclusion of obviousness.

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<sup>3</sup> *Cf. Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (explaining that whether there is "a reasonable expectation of success in making the invention via" a combination of prior art elements is a question of fact).

Therefore, we find Appellants' arguments unavailing regarding the combinability of the cited references for essentially the same reasons proffered by the Examiner in the Answer, and as further discussed above. Accordingly, we find the Examiner did not err by improperly combining the Stefik and Chang references under § 103.

### CONCLUSION

For at least the aforementioned reasons (discussion of Issues 1 and 2), we affirm the Examiner's rejection of representative claim 1. Claims 2-44 fall therewith. *See* 37 C.F.R. § 41.37(c)(vii).

### DECISION

We affirm the Examiner's § 103 rejection of claims 1-44.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### ORDER

### AFFIRMED

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